REMARKS

The Examiner maintains the rejection of all claims under 35 U.S.C. §§ 102 and 103. Applicants again traverse all rejections.

Applicants again point out that independent 1 one is a means plus function claim entitled to the benefit of 35 U.S.C. § 112, 6th paragraph, interpretation, as are all claims dependent therefrom. The Examiner still has not given claim 1 an appropriate interpretation under this section of the code, to wit, "means plus function" elements substantially as shown and described.

The Examiner rejected claims 1 through 12 and 14 through 24 under 35 U.S.C. § 102(b) as being anticipated by Narita. In response to Applicants' arguments, the Examiner indicates that "final intended position" and similar elements must be defined in the claims and cites *In Re Van Geuns*, 988 F.2d 1181, 26 U.S.P.Q.2d 1057 (CAFC 10 March 1993) in support of this statement. Specifically, the relevant portion (1184-1185) of the case reads as follows:

> **Van Geuns' claim 42 recites a magnet assembly with a "uniform magnetic field."** The board found that the Japanese reference disclosed a magnet assembly with a substantially uniform magnetic field, varying no more than 10 percent. Van Geuns does not disagree with this finding. Instead, Van Geuns argues that the uniform magnetic field limitation of claim 42 must be interpreted in light of the specification [**7] and the understanding of persons skilled in the NMR and MRI art. Van Geuns then contends that the Japanese reference does not make the invention of claim 42 obvious because it does not teach the level of magnetic field uniformity required for NMR imaging. The short answer is that claim 42 is not expressly limited to NMR or MRI apparatus. In the patentability context, claims are to be given their broadest reasonable interpretations. *In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).* Moreover, **limitations are not to be read into the claims from the specification. Id. Thus, Van Geuns cannot read an NMR limitation into [*1185] claim 42 to justify his argument as to the meaning of the "uniform magnetic field."** [Emphasis added]

Our case is distinguished since "uniform magnetic field" has a clear ordinary definition that Van Geuns tried to narrow with additional limitations from the specification regarding NMR and MRI. In our case, "final intended position" and the similar elements appearing in Applicants' claim do not have clear ordinary definitions apart from those provided in the specification. Thus, *In re Van Geuns* does not apply, and the terms in Applicants' claims must be read as defined by Applicants as their own lexicographers in Applicants' disclosure.

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Applicants respectfully reiterates that Narita's plurality of gear trains selectively actuated by an electromagnetic clutch assembly has little to do with the claimed invention, particularly claim 1, which must be read under 35 U.S.C. § 112, 6th paragraph. The portions of the reference include no disclosure of advancing paper short of a particular point and then finally advancing, as by incrementally moving the paper in much smaller steps, to the destination as claimed, for example, in Applicants' independent claims 1, 9, 16, and 24. Applicants agree that Narita's device can stop the paper at any point, but Narita does not disclose the final advancer according to Applicants' claims. Just because an apparatus *can* do something does not mean that it *does* do this, especially when the description of the manner of making and using the device does not include a respective description. Depending claims in each claim set recite additional limitations with regard to backlash reduction that are not even addressed by any of references.

Inasmuch as the references applied do not disclose or suggest ***all*** limitations of the independent claims or the dependent claims, Applicants respectfully submit that no *prima facie* case has been established for anticipation or obviousness. The rejections are improper and should be withdrawn, and the claims should be allowed.

In view of the foregoing amendments and remarks the subject application is believed to be in condition for allowance. Therefore, further consideration and allowance of the subject application is requested. If the Examiner considers personal contact advantageous to the disposition of this case, please call Applicants' Attorney, David E. Henn at (585) 423-4299, Xerox Corporation, Rochester, New York 14644, or fax him at (585) 423-5240.

Respectfully submitted,

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